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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,677	01/04/2002	Stephen Brian Falder	16644/09003CIP	9699
27530	7590	02/23/2005	EXAMINER	
NELSON MULLINS RILEY & SCARBOROUGH LLP			PRYOR, ALTON NATHANIEL	
P.O. BOX 11070			ART UNIT	
COLUMBIA, SC 29211			PAPER NUMBER	

1616

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/039,677

**Applicant(s)**

FALDER ET AL.

**Examiner**

Alton N. Pryor

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 18 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1,46-54,56,58,59,61,62,70,71,78,81-100,103 and 104 is/are pending in the application.
- 4a) Of the above claim(s) 49,53,86-91,93-98 and 100 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1,46-48,50-52,54,56,58,59,61,62,70,71,78,82-85,92,99,103 and 104 is/are rejected.
- 7) ☐ Claim(s) 81 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

- I. Rejections of claims under 35 USC 112, 1<sup>st</sup> and 2<sup>nd</sup> paragraphs will not be maintained for reason on record and reason as follows. Applicant replaced 'preventing' language from the claims by "reduce or control the formation of".
- II. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection. See below.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1, 46-48, 50-52, 54, 56, 58, 59, 61, 62, 70, 71, 78, 82-85, 92, 99, 103, 104 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson on record in view of Sokol et al (CA 1087955; 10/21/80). Jackson teaches a bacteriologically disinfectant (cleaning agent) composition comprising 0.02-0.2% quaternary compounds such as cetylpyridinium chloride (first compound - hydrophobic with polar nature), or alkyldimethylbenzylammonium (benzalkonium) chlorides (first compound - hydrophobic with polar nature), plus 10% monohydric alcohols such as isopropyl alcohol plus polyhydric alcohols such as polyethylene glycol (second compound - hydrophilic compound or C12-C20 surfactant) plus 0.01-0.15 % phenols such as 3-methyl-4-chlorophenol (first antimicrobial agent). Jackson teaches a method of applying the disinfectant composition to surfaces for the purpose of killing bacteria. See abstract,

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page 4 lines 7-24, page 5 line 11 – page 6 line 5, claims 1-7. Jackson teaches all that is recited in claims except for the composition comprising 1 to 4% polyethylene glycol; a formulation comprising 0.5-2% of the instant antimicrobial composition; and the instant method of adding and mixing ingredients to manufacture the antimicrobial composition.

Jackson also does not teach the instant composition comprising a polysiloxane.

However, Sokol teaches an antibacterial composition comprising polysiloxane. Jackson teaches that the composition is applied to contaminated surfaces to control bacteria growth. It would have been obvious to one having ordinary skill in the art to modify the invention taught by Jackson to include the polysiloxane taught by Sokol. One having ordinary skill in the art would have been motivated to do this in order to enhance the activity of the composition. It would have been obvious to one having ordinary skill in the art to determine the optimum amount of polyethylene glycol to be used in the antimicrobial composition and the optimum amount of antimicrobial composition to used in a formulation. One would have been motivated to do this in order to develop the most effective composition for disinfecting a surface. In a method of preparation the simple act of adding and mixing ingredients is well known and therefore unpatentable.

### III. Applicants' argument / Examiner's response

Applicant argues that there exist no motivation to combine Jackson and Sokol to arrive at instant composition. Examiner disagrees with Applicant for reason on record and reason as follows. Examiner argues there exist ample motivation to combine the teachings of Jackson and Sokol since they have the same utility (i.e. antibactericides). It is obvious to combine teachings having the same utility.

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Applicant argues that Examiner's motivation to combine the siloxane of Sokol into the antimicrobial composition taught by Jackson is not proper since Sokol teaches that siloxane is used primarily as an antifoaming agent and that siloxane does not enhance the cleaning or sanitizing / antimicrobial effect of the mixture. Examiner argues that Applicant claims do not refer to the siloxane as having a cleaning or sanitizing / antimicrobial effect of the mixture. And if Applicant's composition claims did refer to siloxane as having cleaning or sanitizing effect (utility), no patentable weight would be given to the effect (utility) of the siloxane. Note that a statement to utility in a composition claim has no patentable significance.

#### IV. Claim Objection / Election Status

Claim 81 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art does not teach or suggest the elected invention comprising polydimethylhydroxysiloxane. The elected composition comprising benzenethanaminium N-dodecyl-N,N-dimethyl chloride, polydimethylhydroxysiloxane, 2-phenyl phenol, and isopropyl alcohol is allowable.

#### ***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on 571-272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Alton Pryor', is positioned above the printed name.

Alton Pryor  
Primary Examiner  
AU 1616